



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: LeMay et al.

Serial No.: 10/601,771

Filed: June 20, 2003

For: TAPERED TAMPON APPLICATOR

Examiner: Hill, Laura C.

Art Unit: 3761

Confirmation No.: 7298

Customer No.: 27623

Attorney Docket No.: 460.2174USU

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the final Office Action ("Action") mailed on April 20, 2006, Applicant respectfully files herewith a Notice of Appeal and requests review of the present application before filing an appeal brief.

Related Appeals

The issues presented in the present application are not related to any pending appeals.

Status of the Claims

Claims 1 through 6 and 8 through 73 remain pending in this application. Claim 7 has been cancelled. Claims 1, 37, and 72 are independent.

Claims 1 through 6, 8 through 10, 13 through 22, 32 through 61, 63, 64, and 66 through 73 stand finally rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application Publication No. 2001/0056253 to Suga (hereinafter "Suga") in view of U.S. Patent No. 3,895,634 to Berger et al. (hereinafter "Berger").

Claims 11, 12, 23 through 31, 62, and 65 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suga in view of Berger as applied to claim 1, and in further view of U.S. Patent No. 3,765,416 to Werner et al. (hereinafter "Werner").

Clear Errors for Review

Applicants respectfully submit that the Action fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that Suga, taken alone or in combination with Berger, fails to disclose or suggest all of the features of claims 1, 37 and 72, and all claims dependent therefrom.

Nowhere in Suga is a tampon applicator having a tapered insertion tip remotely disclosed or suggested, let alone one with a taper ratio greater than 1 to about 8, as

recited in claims 1 and 37. Figure 2 and page 6, lines 1 through 5 of the present application provides that "the taper ratio, represented by the ratio of the length of the taper projection along a longitudinal, centerline, or horizontal axis of the barrel BD to the projection length along a radius or vertical axis CD, is greater than 1 to about 8."

Suga fails to provide or suggest any dimensions related to the length of the taper projection along a longitudinal, centerline, or horizontal axis of the barrel BD to the projection length along a radius or vertical axis CD, which is not surprising since Suga does not disclose or suggest any tapered applicator. The Action attempts to overcome the fatal deficiency in Suga by annotating Figure 2 of Suga with what is perceived by the Action as the necessary disclosure to meet the claim limitations of the present Application. However, this annotation appears to be done with complete disregard for the fact that there is no support in Suga for such an annotation. It is only through impermissible hindsight reconstruction based solely on the disclosure of the present application that enables the Action to attempt such an annotation of the Suga disclosure to arrive at the claimed invention.

Moreover, even if one were to incorrectly assume that there was support in Suga for the Action's annotations to the Suga disclosure, Applicants respectfully submit that annotated Figure 2 and the related assertions based on annotated Figure 2 set forth in the Action still fall short of disclosing or suggesting the claimed invention. Notably, the annotated 'Alternative projection length' appears to be arbitrarily located in relation to the tip of the applicator and the tip of the tampon (pledget). Length L of the applicator, length A of the pledge, outer diameter D of the applicator, and outer diameter B of the tampon all fail to correspond to any of the dimensions related to the length of the taper projection along a longitudinal, centerline, or horizontal axis of the barrel BD to the projection length along a radius or vertical axis CD set forth in the present invention, which form the basis for the claimed taper ratio.

Therefore, Suga clearly fails to disclose or suggest a tampon applicator with a tapered insertion tip, let alone an insertion tip that has a taper ratio greater than 1 to

about 8, as recited by claims 1 and 37.

Additionally, the Action acknowledges that Suga does not expressly disclose a petal thickness and relies on the disclosure of Berger to cure this deficiency. Applicants respectfully submit that Berger also fails to disclose or suggest a tampon applicator having a tapered insertion tip according to the claimed invention. This is further evidenced by the concession on page 4 of the Action mailed November 16, 2005, stating that Berger does not expressly disclose a taper ratio. Therefore, Berger cannot cure any deficiency noted above with respect to Suga. Accordingly, despite the Action's reliance on Berger for certain disclosure, it remains that the combination of Suga and Berger fails to disclose or suggest a tampon applicator having a tapered insertion tip, as recited in claims 1 and 37.

With respect to independent claim 72, Applicants respectfully submit that Suga taken alone or in combination with Berger also fails to disclose or suggest a tampon applicator with a tapered barrel having a taper ratio of about 1.2 to about 8, wherein the taper ratio is a ratio of a largest radius of the tapered barrel to a radius of the tapered barrel at a base region of the insertion tip. Consistent with the above relating to claims 1 and 37, nowhere in Suga or Berger is a tampon applicator with a tapered barrel remotely disclosed or suggested. Accordingly, Applicants respectfully submit that Suga and Berger, taken alone or in combination, fail to disclose or suggest all of the claimed features recited in claim 72, and claim 73 that depends therefrom.

In view of at least the above, with respect to claims 1, 37 and 72, and all claims dependent therefrom, the Action clearly fails to make a *prima facie* case of obviousness. Notably, (1) Suga and/or Berger fails to disclose or suggest every claim limitation and (2) the Action impermissibly annotates the disclosure of Suga, through hindsight reconstruction based solely on the disclosure of the present invention, to arrive at the claimed invention.

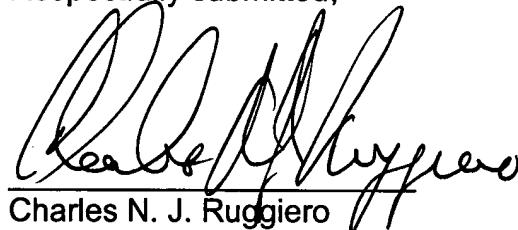
Concerning the rejection of dependent claims 11, 12, 23 through 31, 62, and 65

under 35 U.S.C. §103(a) as being unpatentable over Suga in view of Berger as applied to claim 1, and in further view of U.S. Patent No. 3,765,416 to Werner, Applicants respectfully submit that the rejection cannot be sustained in view of the Action's failure to establish a *prima facie* case of obviousness for independent claims 1 and 37 of the present application.

Applicants respectfully submit that the final rejection is clearly erroneous and, as such, the present application is in condition for allowance. Reconsideration and withdrawal of the all claim rejections and passage of the present application to issuance are respectfully requested. Such action is solicited. If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below.

June 20, 2006

Respectfully submitted,



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